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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYUKI KIHARA and TEPPEI YOKOTA

Appeal 2008-005448
Application 09/674,441
Technology Center 2400

Decided¹: June 17, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-4 and 16. Claims 5-15, 17, and 18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on June 11, 2009. We affirm-in-part.

The Invention

The disclosed invention relates generally to preventing audio data from being illegally copied by storing move history information in an external non-volatile memory (Spec. 98).

Independent claim 16 is illustrative:

16. A data processing method, comprising the steps of:
storing move/copy history indicative of the movement of a particular file when the particular file is moved/copied from a large capacity memory that stores a plurality of files to a non-volatile memory;
referencing the history information stored in the memory when the particular file is moved/copied from the large capacity memory to the non-volatile memory; and
prohibiting the particular file from being moved/copied from the large capacity memory to the non-volatile memory when the history information is stored in the memory.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

Tanaka	US 5,682,549	Oct. 28, 1997
Stock	US 6,011,858	Jan. 04, 2000
Ichimura	US 6,034,832	Mar. 07, 2000

The Rejections

1. The Examiner rejects claims 1-4 and 16 under 35 U.S.C. § 102(e) as being anticipated by Ichimura.
2. The Examiner rejects claims 1-4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Stock and Tanaka.

ISSUE #1

Appellants assert that Ichimura fails to disclose storing move/copy history information “when the particular file is moved/copied from a large capacity memory means to a non-volatile memory” (Reply Br. 3) because “*Ichimura et al.* is directed to copying between the same type of recording media (e.g., DVD to DVD)” (*id.*).

Did Appellants demonstrate that the Examiner erred in finding that Ichimura discloses storing move/copy history indicative of the movement of a particular file when the particular file is moved/copied from a large capacity memory means to a non-volatile memory?

ISSUE #2

Appellants assert that “*Ichimura et al.* discloses that the copy management data . . . is ‘recorded as management information on digital copy in the disc 1’” (Reply Br. 4) but that “[d]isc 1 is a DVD, not flash memory, as recited in dependent claim 4” (*id.*).

Did Appellants demonstrate that the Examiner erred in finding that Ichimura discloses a flash memory?

ISSUE #3

Appellants assert that “the Examiner has failed to establish a prima facie case of obviousness” (App. Br. 9) because “*Stock et al.* does not disclose the movement or copying of a particular file” (*id.* 7), “information with an indication of whether it is history information” (*id.* 8), or “prohibiting the particular file from being moved/copied from said large capacity memory means to the non-volatile memory when said reference means has detected that the history information is stored in said memory means.” (*Id.*).

Did Appellants demonstrate that the Examiner erred in finding that Stock and/or Tanaka disclose or suggest move/copy history information indicative of the movement of a particular file and prohibiting the particular file from being moved/copied from a large capacity memory means to a non-volatile memory when the history information is detected?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Ichimura discloses “DVDs . . . are so-called multimedia discs” (col. 3, ll. 53-56) and “digital copy management . . . on the basis of the . . . DVDs” (col. 3, ll. 57-58).
2. Ichimura discloses “disc **1** is loaded into a reproducing driver **12** in the reproducing apparatus **10**” (col. 3, ll. 64-65), “a reproducing head mechanism for performing data read-out from the rotate disc **1**” (col.

- 3, l. 67 – col. 4, l. 1), and “a servo circuit/servo mechanism for making the spindle mechanism and the reproducing head mechanism execute a proper reproducing operation” (col. 4, ll. 3-5).
3. Ichimura discloses “[c]opy management data . . . are recorded as management information on digital copy in the disc **1**” (col. 4, ll. 30-31) and that “the controller **11** can store into the CMD memory **15** copy management data CMD read out from the disc **1** to perform the processing using the copy management data CMD” (col. 4, ll. 46-49).
 4. Ichimura discloses that the copy management data includes “date-and-hour condition data which permits the reproduction or unallows (inhibits) the reproduction from a specific date” (col. 14, ll. 42-44) and “frequency condition data representing a specific frequency at which the reproduction from the disc **1** concerned . . . is permitted” (col. 15, ll. 18-20).
 5. Ichimura discloses that “[w]hen there is a reproduction request . . . the controller **11** refers to the copy management data CMD” (col. 14, ll. 14-15).
 6. Stock discloses “personal information of the user” (col. 4, l. 30) that includes “one or more of a user’s credit card or charge card accounts, a bank account or debit purse of the user, one or more electronic payment applications, health insurance and/or medical information of the user, etc.” (col. 4, ll. 37-40).

PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citation omitted). “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” (*Id.*) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Issue #1

As described above, Ichimura discloses copying data from a first disc to a second disc and storing “copy management data” in a “CMD memory” (FF 1-3). Ichimura also discloses that the copy management data includes date, time, and frequency data pertaining to data being copied between discs (FF 4).

“The use of the word ‘means,’ which is part of the classic template for functional claim elements, gives rise to ‘a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-functions clauses’.” *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1427 (Fed. Cir. 1997) *citing* *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996). Claim 1 recites the word “means” for functional claim elements. Therefore, a presumption of a means-plus-function clause arises and we “must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994).

Appellants assert that the “large capacity memory means” recited in claim 1 correlates to “Fig. 34, elements 201 (HDD); and FIG. 36, elements HDD 1 and HDD 2) for storing a plurality of files (*Specification*, p. 98, lines 18-20)” (App. Br. 3) and that the “memory means” recited in claim 1 is equivalent to “Fig. 34, element 203” (*id.*). We find no specific disclosure in

the Specification, nor do Appellants state, any specific structure, material or acts associated with “HDD” or “elements HDD 1 and HDD 2” other than the description of such elements as being a “hard disk drive” (see, e.g., Spec. 98). Similarly, we do not find a disclosure in the Specification of any specific structure, material or acts associated with the “Fig. 34, element 203” other than element 203 being represented by a box (Fig. 34) that is “external” to “a host side CPU 202” (Spec. 98).

Presumably, the “hard disk drive” (i.e., “large capacity memory means”) contains a rotating disk and storage elements for storing data. Because the DVD disk of Ichimura is also a “large capacity” disk that rotates in a disk drive and stores data (and thus contains storage elements that stores the data), we find that the DVD disk of Ichimura and the “hard disk drive” disclosed in the instant Specification are equivalent structures. We also find that a DVD disk may also be a “non-volatile memory” because a DVD disk, like a “non-volatile memory” is computer memory that can persistently retain stored information without being powered.

Similarly, in the absence of further disclosed structure, material, or acts in the Specification, we construe the “memory means” as being equivalent to any memory storage device that is “external” (i.e., separate from) a CPU. As described above, Ichimura discloses a “CMD memory” that is separate, and therefore “external” to a CPU (i.e., controller) (FF 3; Ichimura, Fig. 1).

Since the first DVD disk of Ichimura constitutes a “large capacity memory” and the second DVD disk of Ichimura constitutes a “non-volatile

memory,” data is moved or copied from the first DVD disk to the second DVD disk of Ichimura, and the “CMD memory” stores copy management data (which Appellants do not dispute is equivalent to “move/copy history indicative of data movement”), we agree with the Examiner that Ichimura discloses moving or copying a “particular file” (i.e., data) from a large capacity memory to a non-volatile memory and storing copy management data (i.e., “move/copy history” information) in a memory.

At the Oral Hearing, Appellants argued that Ichimura fails to disclose “referencing the history information stored in said memory” as recited in claim 1. However, Ichimura discloses storing copy management data (i.e., “move/copy history”) within the memory “to perform the processing using the copy management data CMD” (FF 3) and further discloses accessing the copy management data (FF 5). Since the accessed “copy management data” had previously been stored in “CMD memory 15,” the accessed copy management data is the same as that stored in the CMD memory 15. This would be true regardless from where the copy management data is referenced. Alternatively, the copy management data stored in CMD memory 15 of Ichimura is used to “perform the processing” (FF 3) which indicates that the data stored in CMD memory 15 is, in fact, used to process (i.e., copy/move) the data from the DVD disk. Therefore, we cannot agree with Appellants that Ichimura fails to disclose accessing (or referencing) history information that is also stored in a particular memory.

Independent claim 16 recites equivalent features as claim 1 but does not recite the word ‘means’ as part of the classic template for functional

claim elements. Therefore, no presumption of a means-plus-function clause applies to claim 16. Nevertheless, our analysis for claim 1 applies to independent claim 16.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 1 or claim 16, or of claims 2-4, which fall therewith with respect to issue #1.

Issue #2

While Ichimura discloses a DVD disk, we do not find, and the Examiner has not demonstrated that Ichimura also discloses a flash memory, which is an established term of the art that includes a semiconductor memory device.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claim 4 with respect to issue #2.

Issue #3

As described above, Stock discloses storing a user's personal information including, for example, "credit card or charge card" information, on a memory card (FF 6). The Examiner finds that "[t]he information specific to a user or move/copy information for a particular user is stored and maintained on the card" (Ans. 14) but has not demonstrated that such "user information" is equivalent or suggestive of "move/copy

information” that is “indicative of the movement of a particular file” as recited in claim 1. Nor has the Examiner demonstrated that Stock and/or Tanaka discloses prohibiting a file from being moved/copied when the move/copy information is detected in memory. Indeed, even assuming a “user’s credit card or charge card account” constitutes “move/copy history information,” we do not find, and the Examiner has not demonstrated, that Stock or Tanaka teaches or suggests prohibiting movement of any data based on the detection of the presence of a user’s credit card or charge card account in memory.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 1-4 and 16 with respect to issue #3.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have failed to demonstrate that the Examiner erred in finding that Ichimura discloses storing move/copy history indicative of the movement of a particular file when the particular file is moved/copied from a large capacity memory means to a non-volatile memory (issue #1).

However, Appellants have demonstrated that the Examiner erred in finding that Ichimura discloses a flash memory (issue #2) and that Stock and/or Tanaka discloses or suggests move/copy history information indicative of the movement of a particular file and prohibiting the particular

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file from being moved/copied from a large capacity memory means to a non-volatile memory when the history information is detected (issue #3).

DECISION

We affirm the Examiner's decision rejecting claims 1-3 and 16 under 35 U.S.C. § 102(e). We reverse the Examiner's decision rejecting claim 4 under 35 U.S. C. § 102(e) and claims 1-4 and 16 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART.

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